

REMARKS

Claims 1 through 22 remain pending in this application. Allowance of claim 20, indication of the allowability of dependent claims 11, 16 and 19, are noted with appreciation. Claim 21 is amended in minor particulars to assure antecedent basis.

The Examiner objected to the drawings under 37 C.F.R. §1.83(a) as failing to illustrate the features defined by dependent claims 10 through 18. Rue 83 however provides that “conventional features disclosed in the description and claims, whether detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawings in the form of a graphical drawing symbol or labeled representation (*e.g.*, a labeled rectangular box.)” Applicant notes that the Examiner has not previously raised this issue, and that the raising of this issue for the first time in a final Office action is either impermissible or renders the action prematurely final. Moreover, the Examiner has repeatedly rejected these claims as illustrating subject matter that is either anticipated or rendered obvious by the art of record. Applicant suggests therefore, that the Examiner postpone the requirement for submission of the formal drawings until all remaining claims have been placed in condition for allowance or, alternatively, withdraw the requirement. Alternatively, should the Examiner find after reconsideration that the formal drawings are necessary, Applicant will prepare formal drawings with labeled rectangular boxes for each of the features identified by the Examiner.

The Examiner's assertion about dependent claim 15 is improper, and the Examiner has cited language that is taken out of context; clarification of the Examiner's understanding of the language of claim 15 in its entirety, is requested. Applicant notes that the express features defined by claim

15 are clearly illustrated by the drawings.

With respect to dependent claim 16, it is difficult to understand why Fig. 1 does not satisfy the requirements of Rule 83; reconsideration and withdrawal of the objection to the features defined by claim 16 are requested.

Applicant also notes that the features defined by dependent claim 18 are clearly and visibly shown by Fig. 1; reconsideration and withdrawal of the objection to the drawings showing the subject matter of claim 18, are requested.

Claim 21 was rejected under the second paragraph of 35 U.S.C. §112 as raising questions of antecedent basis. This is not a question of patentability, and claim 21 is readily understandable in its original form. Claim 21 is amended however, to conform to the ancient notion of antecedent basis. Withdrawal of the rejection is therefore proper.

Claims 1 through 6, 9, 11, 17 and 18 stand finally rejected under 35 U.S.C. §102(b) for alleged anticipation by Martin U.S. Patent No. 2,448,611. Applicant expressly traverses this rejection for the following reasons.

Martin '611 is well prepared and carefully written U.S. patent. The express teachings of Martin '611 however, contradict the Examiner. Moreover, the Examiner has expressly ignored in paragraph 5 of Paper No. 17, the language of the rejected claims.

All of Applicant's rejected claims expressly define, *inter alia*, "magnetic members ... to permit contact therebetween" in combination with "a cover member covering said magnetic

members ... to permit the page of the book to be readily received within said throat of the clip marker” (see claim 1, line 7-11). In contradistinction, Martin '611 expressly teaches a structure which, as illustrated in Figs. 2, 3, 6 and 7, as axial protrusions created by the combination of magnets 10 and covers 12 so that, in order:

“To use the book mark, the ends of the mark having the magnets secured therein are *separated* and *placed* on opposite sides of the page to be marked. The magnets will be mutually attracted through the page and will therefore remain in position until removed.”

This feature is faithfully reflected in each of claims 1-4 of Martin '611, that define the book mark of Martin '611 as having the magnets “attracted when *placed* in alignment on opposite sides of the page to be marked. The exaggeration of the protrusion of magnets 10 caused by covering those magnets with the ends 12 in Martin '611 requires that the magnets be “*separated* and *placed* on opposite sides of the page,” and prevents the provision of the structure defined by Applicant's claim 1 with “contact therebetween [the magnetic members] in combination with the “cover member ... to permit the page of the book to be *readily received* within said throat of the clip marker.” In stead, Martin '611 requires a two step process of use to compensate for the exaggerated axial protrusions of his covered magnets, and thereby compensate for the obstruction to insertion of a page caused by the exaggerated protrusion of those covered magnets. The Examiner's attention is invited to page 8 of Applicant's originally filed specification, where Applicant describes the advantages provided by the interaction of the quoted features from the rejected claims as advantageously facilitating “the page sliding (6) and prevents the impingement between the edge (6') of the page and the permanent edges (8) of the

magnetic means (3)(4), as it can be observed in Figs. 3, 3A and 5.” Moreover, the structure of Martin '611 lacks the foregoing features in conjunction with Applicant's “pair of wall members aligned and joined together ... to define a throat therebetween ...” as set forth in lines 3-5 of parent claim 1. As noted by the Examiner, throat 24 of Martin '611 is defined not by the wall members aligned and joined together, but by a second member 18 extending from the oblique, unnumbered lines adjacent to reference symbol 20 shown in Figs. 2 and 7. Consequently, the second member 18 fails to provide Applicant's structure with the magnetic members in combination with a cover member enabling “the page of the book to be readily received within said throat” Under the all elements rule, these claims can not be anticipated by Martin '611.

Claims 7, 8, 10, 12 and 22 stand finally rejected under 35 U.S.C. §103(a) for alleged unpatentability over Martin '611. As noted in the foregoing paragraphs, Martin '611 lacks the interaction and combination of elements defined by parent claim 1. In short, Martin '611 fails to provide a *prima facie* showing of obviousness.

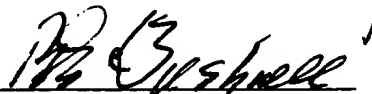
Claims 13 and 14 were finally rejected under 35 U.S.C. §103(a) for alleged unpatentability over Martin '661 in view of Johnson U.S. Patent No. 2,630,777 while claim 15 was rejected under 35 U.S.C. §103 for alleged unpatentability over Martin '661 in view of Schwartz U.S. Patent No. 5,380,043. Applicant respectfully traverses these rejections because supplementation of the primary reference with these secondary references fails to satisfy the foregoing omission in the primary reference. Accordingly, withdrawal of these rejections and allowance of these claims are required.

Entry of the foregoing amendments under 37 C.F.R. §1.116(b) is requested, and is proper, because the foregoing amendment of allowable claim 21 simply changes the articles "said" to conform with ancient notions of antecedent basis, raise no issues and require no further searches and consideration.

In view of the above, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Reconsideration of the rejections and objections is requested. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

No fee is incurred by this Amendment.

Respectfully submitted,


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VERSION WITH MARKINGS TO SHOW CHANGES MADE
IN THE CLAIMS

Please amend claim 21, as follows:

1 21. (Amended) A magnetic clip marker for use in engaging and marking a page of a book,
2 the clip marker including in combination:

3 a plurality of discrete magnetic members each exhibiting a thickness;

4 a pair of wall members of unequal length aligned and joined together at a throat to form an
5 integral monolithic structure exhibiting a normally closed orientation, with said wall members
6 comprised of a base portion adjacent [said] terminal ends and a clip portion overlapping said base
7 portion and extending to said throat, said wall members being oriented to receive insertion of a page
8 of a book between said base portion and said clip portion until an edge of the page engages said
9 throat, said wall members bearing said magnetic members mounted on between said wall members,
10 in aligned facing opposition to permit contact between said magnetic members; and

11 a cover member disposed along [said] an interior surface of one of said pair of wall members
12 to form a continuous layer extending from a first of said [distal] terminal ends, around said throat
13 and to a second of said [distal] terminal ends while covering and separating said magnetic members
14 and forming a continuously gradual structural transition between a difference in separation between
15 said opposite wall members and between said magnetic members attributable to said thickness.